

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: John W. Forsberg; Mark E. Confirmation No. 9349
Schommer; David P.
Olson; William C. Phillips;
Alex C. Toy; Charles R.
Lewis, Jr.

Serial No.: 10/693,005

Filed: October 24, 2003 Customer No.: 28863

Examiner: Christopher A. Flory

Group Art Unit: 3762

Docket No.: 1023-294US01

Title: MEDICAL DEVICE PROGRAMMER WITH INFRARED
COMMUNICATION

SUPPLEMENTAL REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450,
Alexandria, VA 22313-1450

Sir:

This is a Supplemental Reply Brief responsive to the final Office Action mailed March 21, 2008, the Advisory Action mailed October 1, 2008, the Examiner's Answer dated April 1, 2009, and the Supplemental Examiner's Answer dated September 23, 2009. The due date for this Reply Brief is November 23, 2009.

No fees are believed to be due at this time. Please charge any fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

TABLE OF CONTENTS

	<u>Page</u>
Status of Claims.....	3
Grounds of Rejection to be Reviewed on Appeal	4
Argument	5

STATUS OF CLAIMS

Claims 1–12, 14–21, and 32 are pending and are the subject of this Appeal. Claim 13 and 22–31 were previously canceled. Claims 1–12, 14–21, and 32 are set forth in Appendix A of the previously filed Appeal Brief. The originally filed application included claims 1–19. Claim 13 was canceled and claims 20–31 were added in a Preliminary Amendment filed on March 9, 2004. Claims 22–31 were canceled and claim 32 was added in an Amendment filed on August 30, 2006.

Claims 1–12, 14, 15, 17–21, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Meadows et al. (U.S. Patent No. 6,516,227, hereinafter referred to as Meadows) in view of Whitehurst et al. (U.S. Patent Application Publication No. 2003/0229383, hereinafter referred to as Whitehurst). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meadows in view of Whitehurst and further in view of Stanton et al. (U.S. Patent No. 6,249,703, hereinafter referred to as Stanton).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant submits the following grounds of rejection to be reviewed on appeal:

1. The rejection of claims 1–12, 14, 15, 17–21, and 32 under 35 U.S.C. § 103(a) as being obvious over Meadows in view of Whitehurst; and
2. The rejection of claim 16 under 35 U.S.C. § 103(a) as being obvious over Meadows in view of Whitehurst and further in view of Stanton.

ARGUMENT

In the Supplemental Examiner's Answer provided in response to Appellant's Reply Brief, the Examiner withdrew several new grounds of rejection presented in the first Examiner's Answer and provided a clarification of the rejection of the claims, as well as a new ground of rejection. For brevity, this Supplemental Reply Brief only addresses aspects of these new arguments. Accordingly, this Supplemental Reply Brief is not intended to address all arguments provided in the Supplemental Examiner's Answer, and Appellant requests full consideration of all arguments set forth in the Appeal Brief filed on December 8, 2008 and the Reply Brief filed on June 1, 2009.

Claims 11, 12, 14, and 17

As discussed in the Appeal Brief, the Examiner did not cite any prior art references that disclose a programmer that includes telemetry circuitry and display and display circuitry on separate circuit boards, as recited by claim 11 (claims 12, 14, and 17 depend from claim 11). In support of the rejection of claim 11, the Examiner merely stated that it would have been obvious to use a "two circuit board design."¹ In the Supplemental Examiner's Answer, the Examiner referred to "any 'clamshell' style cell phone," and asserted that in such cell phones, the antenna and telemetry circuitry are contained in half of the phone held in the hand and the display is contained on the portion that flips open.² The Examiner further asserted that in laptop computers, "the display is housed in a portion that flips open and the antenna is contained in the part containing the motherboard, keyboard, etc." Neither of these assertions, however, establishes that it would have been obvious to one having ordinary skill in the art to modify a medical device programmer to include telemetry circuitry on one circuit board and display and display circuitry on another. Rather, the Examiner's arguments are only directed to placing a display and antenna in separate portions of a device, which does not necessarily require the telemetry circuitry to be on a separate circuit board from a display and display circuitry.

¹ Supplemental Examiner's Answer at p. 18.

² *Id.*

Moreover, the devices referred to by the Examiner do not relate to medical devices. Therefore, the Examiner appears to have misunderstood the requirements of Appellant's claim 11.

Moreover, the Examiner did not provide any references to support the assertions that "clamshell" style cell phones and/or laptops necessarily include an antenna and display circuitry on separate circuit boards. Indeed, the Examiner failed to provide any support for this assertion. Thus, in the Supplemental Examiner's Answer, the Examiner appeared to be relying on common knowledge in the art to support the rejection of claims 11, 12, 14, and 17. While the Examiner asserted that the reliance on the "clamshell style cell phone" is not a new ground of rejection, the Examiner has not previously asserted that such cell phones include telemetry circuitry and display and display circuitry on separate circuit boards. Rather, the Examiner's previous rejection merely relied on a two circuit board design without any reference to the telemetry circuitry and display and display circuitry being on separate circuit boards.

Appellant disagrees that it is common knowledge that "clamshell" style cell phones and/or laptops necessarily include an antenna and display on separate circuit boards. It is appropriate for the Examiner to take official notice of facts without supporting documentary evidence or to rely on common knowledge in the art in making a rejection where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known.³ The assertions by the Examiner that "any 'clamshell' style cell phone" includes a display "in a portion that flips open" and an antenna "contained in the part containing the motherboard, keyboard, etc." and that the "same is true of laptop computers" are not capable of instant and unquestionable demonstration as being well-known. Specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art,⁴ which the Examiner has failed to provide. Therefore, the Examiner is improperly relying on an assertion of knowledge in the art to support the rejection of claims 11, 12, 14, and 17, and the rejection of claims 11, 12, 14, and 17 should be reversed at least this basis.

The Examiner failed to demonstrate that each and every element of claim 11 is found within the prior art and failed to provide a rational reason for placing the telemetry circuitry and

³ See *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970).

⁴ *Id.* at 1091.

display and display circuitry on separate circuit boards. For at least these reasons, the Examiner's rejection of claims 11, 12, 14, and 17 was erroneous and should be reversed.

Claim 15

Claim 15 recites a programmer including an internal antenna defining an aperture and a battery bay extending at least partially into the aperture. In the Supplemental Examiner's Answer, the Examiner continued to rely on Causey et al. (U.S. Patent Application Publication No. 2002/0002326, hereinafter referred to as Causey) and Malek (U.S. Patent Application Publication No. 2003/0177031) as teaching an internal antenna defining an aperture and a battery bay extending at least partially into the aperture.⁵ As noted in the Appeal Brief, neither Causey nor Malek disclose or suggest the features of claim 15.

In the Supplemental Examiner's Answer, the Examiner withdrew the reliance on the Samsung SCH-u740 cell phone to support the rejection of claim 15 (as presented in the first Examiner's Answer) and shifted his reliance to "almost any style cell phone" to support the rejection of claim 15.⁶ Specifically, the Examiner asserted that "almost any style cell phone clearly reads on the claim limitation."⁷ The Examiner continued to maintain that "[r]emoval of the battery cover of such a cell phone clearly reveals that the antenna extends into the battery bay."⁸ As an initial matter, Appellant notes that claim 15 does not recite an antenna that extends into a battery bay. Instead, claim 15 specifies that the internal antenna of a programmer defines an aperture and the programmer further comprises a battery bay that extends at least partially into the aperture.

Moreover, the record is unclear as to whether the Examiner actually removed a battery cover of a cell phone or whether such an assertion is merely conjecture. The Examiner is relying on an improper assertion of personal knowledge of "such a cell phone" to support to rejection of claim 15. In particular, the Examiner has not provided an affidavit or declaration setting forth specific factual statements and explanation to support the assertions with respect to the asserted

⁵ Supplemental Examiner's Answer at p. 19.

⁶ *Id.*

⁷ *Id.*

⁸ *Id.*

structure of “almost any style cell phone.”⁹ As provided in 37 C.F.R. 1.104(d)(2), “when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” However, in the present case, the Examiner has not provided Appellant with the opportunity to request an Affidavit or to contradict any assertions personal knowledge by the Examiner. Appellant has filed a Petition under 37 C.F.R. 1.181(a) requesting that the ground of rejection of claim 15 that relies on personal knowledge of the Examiner, which was first set forth in the Supplemental Examiner’s Answer, be designated as a new ground of rejection.

The Examiner’s reliance on “almost any style cell phone” fails to amount to a reliance on proper concrete evidence in the record to support the rejection of claim 15, such as a prior art reference.¹⁰ Therefore, the reference to “almost any style cell phone” is insufficient to establish obviousness of claim 15. The rejection of claim 15 should be reversed based at least on the Examiner’s erroneous interpretation of claim 15 as well as the improper reliance on “almost any style cell phone,” which has not been established as prior art.

The Examiner has not cited any references that teach or suggest the programmer recited in Appellant’s claim 15. The Examiner’s reliance on personal knowledge without further support found within a prior art reference is improper, and the rejection of claim 15 should be reversed.

⁹ See 37 C.F.R. 1.104(d)(2).

¹⁰ See 35 U.S.C. § 103(a) (“A patent may not be obtained though the invention is not identically disclosed or described . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious . . . ”).

CONCLUSION

For at least these reasons and the reasons discussed in Appellant's Appeal Brief, the Examiner has failed to establish a *prima facie* case for obviousness of Appellant's claims 1–12, 14–21, and 32. In view of Appellant's arguments present in this Reply Brief and in the previously-filed Appeal Brief, the final rejection of Appellant's claims was improper and should be reversed. Reversal of all pending rejections and allowance of all pending claims is respectfully requested.

Date:

November 23, 2009

SHUMAKER & SIEFFERT, P.A.
1625 Radio Drive, Suite 300
Woodbury, Minnesota 55125
Telephone: 651.283.8346
Facsimile: 651.735.1102

By:

Jessica H. Kwak
Name: Jessica H. Kwak
Reg. No.: 58,975